

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. KENNEDY III, MICHAEL J. TZIVANIS, VIKTOR KELLER,
WILLIAM M. RISEN JR., MARK L. BINETTE, and JOHN L. NEALON

Appeal No. 2004-1184
Application No. 10/074,849

ON BRIEF

Before WALTZ, TIMM, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 46 through 53. Claims 27-45 are the remaining claims pending in this application and stand withdrawn from further consideration as drawn to a non-elected invention (final Office action dated Apr. 17, 2003, Paper No. 10, pages 1-2; Brief, page 2). We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a golf ball comprising a core, an inner cover layer having a Shore D

hardness of at least 60 and formed from a specified composition, and an outer cover layer formed over the inner cover layer, where the golf ball has a spin factor of at least 5 (Brief, page 3, as modified by the Reply Brief, page 2). Appellants state that claims 46-53 stand or fall together (Brief, page 4). Therefore we select the broadest claim (independent claim 46) as representative of the grouping of claims and decide the grounds of rejection in this appeal on the basis of this claim alone. See 37 CFR § 1.192(c)(7)(2000). Of course, we also consider claim 51 on appeal since it is the subject of a separate rejection. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 46 is reproduced below:

46. A golf ball comprising:

a core;

an inner cover layer which has a Shore D hardness of at least 60 as measured on the curved surface thereof and is formed from a composition which includes at least one material selected from the group consisting of polyphenylene ether/ionomer blends, ionomers, polyamides, polyurethanes, polyester elastomers, polyester amides, metallocene catalyzed polyolefins, and blends thereof; and

an outer cover layer formed over the inner cover layer, the golf ball having a spin factor of at least 5.

Appeal No. 2004-1184
Application No. 10/074,849

The examiner has relied upon the following references as evidence in support of the rejections on appeal:

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|---------------------------------|-----------|--|
| Nesbitt | 4,431,193 | Feb. 14, 1984 |
| Sullivan (Sullivan '105) | 5,098,105 | Mar. 24, 1992 |
| Sullivan et al. (Sullivan '894) | 6,213,894 | Apr. 10, 2001 |
| Yabuki | 6,359,066 | Mar. 19, 2002 (filed Mar. 28, 1997) |

Claims 46-50, 52 and 53 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nesbitt (Answer, page 3). Claim 51 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Nesbitt in view of Sullivan '105(*id.*). Claims 46-53 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of Sullivan '894 (final Office action, Paper No. 10, page 4, and the Answer, page 7). We *affirm* all of the rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

A. The Obviousness-type Double Patenting Rejection

Appellants do not contest or dispute this rejection but state that a terminal disclaimer will be filed once the "other issues" have been resolved (Brief, page 3). Accordingly, we summarily

affirm the examiner's rejection of claims 46-53 under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of Sullivan '894.

B. The Rejection under § 102(b)

The examiner finds that Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer, where the inner cover layer is made from a hard, high flexural modulus resinous material such as Surlyn® 1605 (Answer, page 3). The examiner applies Yabuki as evidence that Surlyn® 1605 has a Shore D hardness of 62, as well as a flex modulus of 44,961 psi (Answer, pages 3-5).¹ Since the examiner also finds that the inner cover layer thickness, the outer cover layer thickness, the coefficient of restitution (COR), and the preferred core material (polybutadiene) of Nesbitt are the same or overlap with these variables of the claimed golf ball, the examiner concludes that the spin factor of the Nesbitt golf ball would inherently be the same as the claimed golf ball spin factor (Answer, pages 3-6). We agree.

¹The examiner finds that Surlyn® 1605 is identical to hi-milan 1605 (Answer, page 4). Appellants do not contest this finding (see the Brief and the Reply Brief in their entirety). Appellants also teach that Surlyn® 1605 is now designated as Surlyn® 8940 with a flex modulus of about 51,000 psi (specification, page 3, ll. 25-29).

Appellants argue that Nesbitt does not disclose or claim the specific Shore D hardness of the inner cover layer, nor limit the cover to materials having a specific Shore D (Brief, sentence bridging pages 4-5). Appellants are correct that Nesbitt does not disclose or claim any specific Shore D hardness of the inner cover layer. However, appellants have not disputed the examiner's finding that the exemplified inner cover layer of Nesbitt (Surlyn® 1605) has a Shore D hardness of 62, which is within the scope of claim 46 (which recites a Shore D hardness of "at least 60"). Appellants have not contested the examiner's finding from Yabuki that Surlyn® 1605 possesses a Shore D hardness of 62 (see the Brief and Reply Brief in their entirety). Therefore appellants' argument is not persuasive as an example of Nesbitt falls within the scope of the hardness as generically recited in claim 46 on appeal. See *In re May*, 574 F.2d 1082, 1089, 197 USPQ 601, 607 (CCPA 1978).

Appellants argue that Nesbitt does not disclose or claim a spin factor at all (Brief, page 5). Appellants argue that the examiner has not met the burden of providing a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the prior art (*id.*).

The "spin factor" is a complex set of measurements and calculations using many different golf clubs (see the specification, pages 45-46). This "spin factor" is not recognized in any prior art other than some of appellants' own patents. Contrary to appellants' arguments, we determine that the examiner has provided sufficient evidence to establish a reasonable belief that the spin factor of the Nesbitt golf ball would have inherently been the same as the claimed spin factor. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); and *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). As found in the Answer, the golf ball of Nesbitt has the same range of thicknesses for the inner and outer cover, the same materials for the core, inner and outer covers, with the same flex modulus for the inner cover, as well as a coefficient of restitution which is the same as the claimed golf ball.² Therefore we determine that

²We note that the COR taught by Nesbitt of 0.800 or more applies to the core and inner layer, while the COR disclosed and claimed by appellants of at least 0.750 applies to the entire golf ball (e.g., see claim 53 on appeal). However, appellants do not dispute or contest the examiner's finding that the COR of Nesbitt falls within the scope of COR values disclosed and taught by appellants. Furthermore, Nesbitt teaches that the COR of the entire golf ball must be "comparatively high" so that the ball closely approaches the maximum permitted initial velocity specified by the USGA (col. 3, ll. 8-15). Accordingly, for purposes of this appeal, we accept the examiner's finding as fact (continued...)

the examiner has met the initial burden of proof and shifted this burden to appellants. *See In re Spada, supra; In re Best, supra.* We note that appellants have not relied on any evidence to attempt to establish that the golf ball of Nesbitt does not possess the spin factor as recited in claim 46 on appeal.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a reasonable belief that all of the claimed limitations are described or inherent in Nesbitt. Accordingly, we affirm the rejection based on section 102(b).

C. The Rejection under § 103(a)

The examiner applies Nesbitt for the findings as discussed above and in the Answer (Answer, page 3). The examiner recognizes that the flex modulus of the outer cover layer of Nesbitt is above the claimed range (Answer, sentence bridging pages 3-4; see also the specification, page 4, ll. 1-3). The examiner finds that Sullivan '105 teaches an ionomer for a golf ball cover layer with a flex modulus of 2500 to 3500 psi (Answer, page 4). From these findings, the examiner concludes that it would have been obvious to

²(...continued)
that the COR of the Nesbitt golf ball falls within the range of COR values of appellants' claimed golf ball.

one of ordinary skill in this art to use the ionomer of Sullivan '105 for the outer cover layer of Nesbitt (*id.*).

Appellants argue that Sullivan '105 is directed to a single layer cover for a golf ball, while Nesbitt is directed to a multi-layer golf ball cover, and the examiner has not provided any motivation for combining these references as proposed (Brief, pages 6-8). Furthermore, appellants argue that the flex modulus taught by Sullivan '105 represents Iotek 7520 alone, while the reference only teaches cover layers formed from a blend of Iotek 7520 and another (hard) ionomer (Brief, page 7).

These arguments are not persuasive. The examiner has not applied Sullivan '105 for a teaching of a cover layer to replace the cover layer of Nesbitt. The examiner cites Sullivan '105 for its teaching that an *ionomer* with a flex modulus of 2500-3500 psi was known in this art. Since Nesbitt generically teaches that the outer cover layer should be of "soft, low flexural modulus resinous material" (col. 1, ll. 52-53), the examiner has applied Sullivan '105 for its teaching that another soft, low flex modulus resinous material was known in the art as useful in golf ball cover layers. Accordingly, we determine that the examiner has established that it would have been *prima facie* obvious to use an ionomer such as Iotek

Appeal No. 2004-1184
Application No. 10/074,849

7520 which meets the requirements of the outer cover layer of the Nesbitt golf ball.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Accordingly, we affirm the examiner's rejection of claim 51 under section 103(a).

D. Summary

The rejection of claims 46-53 under the judicially created doctrine of obviousness-type double patenting over claims 1-42 of Sullivan '894 is affirmed.

The rejection of claims 46-50, 52 and 53 under 35 U.S.C. § 102(b) over Nesbitt is affirmed. The rejection of claim 51 under 35 U.S.C. § 103(a) over Nesbitt in view of Sullivan '105 is affirmed.

The decision of the examiner is affirmed.

Appeal No. 2004-1184
Application No. 10/074,849

No time period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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| THOMAS A. WALTZ |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| CATHERINE TIMM |) | APPEALS |
| Administrative Patent Judge |) | AND |
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TAW/jrg

Appeal No. 2004-1184
Application No. 10/074,849

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